

*REMARKS*

Claims 26-46 are pending in this application. Currently no claims stand allowed.

**35 U.S.C. § 101**

The Office action rejects claims 26-32, 34-36, and 38-41 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. As currently amended, independent claims 26 and 34 are directed to statutory subject matter. Amended claim 26 clarifies that the first and second sets of one or more computer programs, as well as the at least one user interface resource file, are each "embodied in a computer-readable medium." The system recited in amended claim 34 includes a computer having a memory in which the executable computer program is stored. The at least one user interface resource file and the set of one or more computer programs are each specified as being "embodied in a computer-readable medium." Claims 25-32, which incorporate the elements of claim 26, and claims 35-36, which incorporate the elements of claim 34, are similarly compliant with the requirements of 35 U.S.C. § 101. Claims 27-28 and 35-36 have been amended in order to make the claim language consistent with the amended language of claims 26 and 34, respectively.

Claim 38, which has not been amended, is a statutory process claim, and applicants therefore respectfully request that the rejections of claims 38-41 based on 35 U.S.C. §101 be withdrawn. While it is true that claim 38 does not recite a method that is wholly "computer-implemented," it does recite a computer-related method that, by its express terms, is limited to a practical application in the technological arts. Claim 38 is a "method for collaboratively developing a computer application software product." This language is no mere statement of intended use; it serves to define the elements in the body of the claim. The first recited step comprises "writing source code for the computer application software product, and generating a

first build of the computer application software product." Subsequent steps include "executing the first build [of the computer application software product]" and performing actions relating to "proposed changes to the user interface [of the computer application software product]."

The requirement that a claimed invention must accomplish a practical application is designed "to limit patent protection to inventions that possess a certain level of 'real world' value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research." MPEP § 2106. Applicants' disclosure certainly demonstrates the practicality of their invention. A claimed process for collaboratively developing a computer application software product is not directed to an abstract idea, a law of nature, or a natural phenomenon. Rather, it is a practical application in the technological arts, because computer application software products are themselves, in general, practical applications in the technological arts. Software engineering exists as a subarea of the computer arts precisely because of the very practical need for efficient production of high-quality software products by teams of developers. *Cf.* Office Action, p. 11 (promotion of more cost effective and efficient software development cited as motivation to combine purported reference teachings). If the Office is contending that applicants' invention is directed "to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result," it has failed to "expressly state how the language of the claims has been interpreted to support the rejection" (MPEP § 2106).

### **35 U.S.C. § 112, Second Paragraph**

The Office action rejects claim 42 under 35 U.S.C. § 112, second paragraph. Applicants have amended claim 42. The steps expressly recited in claim 42 are capable of being tangibly embodied in a computer-readable medium as computer-executable instructions.

**35 U.S.C. §§ 102 and 103**

The Office action rejects claims 26-37 and 43-46 under 35 U.S.C. § 102(b) as being anticipated by two non-patent references: the Adobe FrameMaker+SGML document preparation system, as disclosed by "Adobe FrameMaker+SGML 5.5: Developing SGML Publishing Applications" (1997) (hereinafter *AFM97*), and Charles F. Goldfarb and Paul Prescod, *The XML Handbook* (Prentice Hall, 1998) (hereinafter *Goldfarb*). The Office action also rejects claims 38-41 under 35 U.S.C. 103 as being obvious over *AFM97* and *Goldfarb*.

Neither *AFM97* nor *Goldfarb* anticipates independent claims 26, 34, and 43, nor do they teach or suggest, alone or in combination, independent claim 38. Claims 26 and 38 are directed to the use of a markup language document (the at least one user interface resource file) to create and modify the user interface component of a computer application software product, which also includes an executable program component in a collaborative software development environment. Claims 34 and 43 are directed to the use of the at least one user interface resource file to dynamically customize the user interface for an executable computer program.

Nothing in either *AFM97* or *Goldfarb* teaches the use of markup language documents to specify and dynamically modify a user interface *for an executable computer application*. Moreover, neither *AFM97* nor *Goldfarb* teach or suggest the use of markup language documents as an aid in collaborative software development, or any sort of software development or computer programming. *Goldfarb* describes traditional uses of markup language authoring tools in creating, structuring and editing static informational text documents. The Office action contends that *AFM97* discloses "application development with the FrameMaker+SGML tool", but points to nothing in *AFM97* that even hints at the use of SGML as an aid in designing user interfaces in software development projects.

In rejecting claims 43-46 under 35 U.S.C. § 102(b) and in rejecting claims 38-41 under 35 U.S.C. § 103, the Office action appears to rely heavily on section 21.3 of *Goldfarb*, and particularly its reference to FrameMaker+SGML having a "WYSIWYG environment." The discussion of these rejections in the Office action seems to confuse the distinct notions of a user interface for an interactive executable software application, with the visual appearance of documents or other displayed output in the course of a particular execution of an application. Whether or not an interactive application, such as FrameMaker+SGML or another SGML authoring tool, has a WYSIWYG environment, its user interface is generally fixed once it is distributed to end users; it is not possible to dynamically alter the basic characteristics of the user interface of the application itself. When a user of FrameMaker+SGML works first on one document and then on a second document, the user interface of the FrameMaker+SGML application is not changed when that second document is displayed. Applicants' invention provides mechanisms and techniques for changing the user interface of an application dynamically, an innovation not disclosed or suggested by *AFM97* and *Goldfarb*.

Because independent claims 26, 34, 38 and 43 are neither anticipated by *AFM97* and *Goldfarb* nor obvious over these references, applicants respectfully request that the rejections of these claims be withdrawn. Moreover, because these independent claims are allowable, the claims that depend from them or incorporate their elements are allowable for at least the same reasons.

### **Double Patenting**

Finally, the Office action provisionally rejects claims 26-46 under obviousness-type double patenting as being unpatentable over claims 1-37 of co-pending and commonly-assigned Application No. 09/452,421. Applicants are filing with this response a terminal disclaimer in

In re Application of Andrew et al.  
Application No. 09/506,125

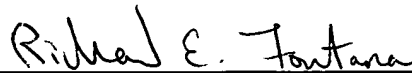
compliance with 37 CFR § 1.321(c) in order to obviate the provisional nonstatutory double patenting rejection over co-pending Application No. 09/452,421.

*CONCLUSION*

The application, including the amendment requested herein, is considered to be in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue.

If, in the opinion of the examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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